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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

46053

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Application Number

10/724,161

Filed

December 1, 2003

First Named Inventor

Kyung-Eun Lee et al.

Art Unit

2426

Examiner

Jivka A. Rabovianski

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 61,789

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

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June 17, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

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PATENT
Case Docket No.: 46053

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: :
: :
Kyung-Eun Lee et al. : Group Art Unit: 2426
: :
Serial No.: 10/724,161 : Examiner: Jivka A. Rabovianski
: :
Filed: December 1, 2003 : Confirmation No.: 9389

For: Digital Multimedia Broadcasting Receiver and Method for Reproducing Digital
Multimedia Data

ARGUMENTS FOR CONSIDERATION FILED CONCURRENTLY
WITH PRE-APPEAL BRIEF REQUEST FOR REVIEW

Attn: Mail Stop AF
P.O. Box 1450
Alexandria, VA 22314-1450

Sir:

In response to the final Office Action of March 17, 2010 and the Advisory Action of May 26, 2010, the Applicants submit the following arguments for consideration with the concurrently filed Pre-Appeal Brief Request For Review.

Remarks/Arguments:

Claims 1-14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Leporini (U.S. Pub. No. 2003/0110382 – hereinafter Leporini) in view of Martin (U.S. Patent No. 7,174,512 – hereinafter Martin). Applicants respectfully traverse this rejection.

I.

With respect to claim 1, as explained in Applicants' specification (hereinafter "the Specification"), the claimed apparatus (hybrid digital broadcasting receiver) is designed to address the problem of a conventional digital media broadcasting receiver (DMBR) in that the DMBR's decoder is confined therewithin such that the decoder cannot do the decoding independently of the conditional access section (CAS) thereof. Specifically, with the claimed apparatus, its decoder module is *separate and independent* from its broadcast receiving module. As such, the decoder module as claimed can do the decoding independently of a CAS.

In the Amendment After Final filed on May 17, 2010 (hereinafter “the May Amendment”), Applicants pointed out that the Examiner errs in failing to give the correct meaning to the claim term “module”. More specifically, in the context of an apparatus, those skilled in the art readily understand that a “module” refers to *a self-contained unit* that can be used in combination with other components. With the claimed apparatus, its decoder module, by definition, is a self-contained unit separate and independent from its broadcast receiving module. In particular, the decoder module as claimed, as reflected by its recitations, allows its decoding section to decode multimedia data from different independent sources and of different nature, namely (1) *decrypted* data (by a CAS) and (2) non-decrypted data (not subject to decryption by a CAS), thus achieving the objective of doing the decoding independently of a CAS.

By contrast, as Applicants point out in the May Amendment, the only modules that Leoporini discloses are: (a) the receiver/decoder 2000; and (b) individual components disposed within the receiver/decoder 2000 (such as descrambler/demux/remux 2010). These disclosed modules, in accordance with the meaning of a “module” as understood by those skilled in the art, do not disclose or suggest the decoder module as claimed *separate and independent* from the broadcast receiving module as claimed.

In particular, it is clear that the Examiner errs in failing to give the correct meaning to the claim term “module”. Specifically, the receiver/decoder 2000 *has already been* cited for the broadcast receiving module as claimed. Hence, the same receiver/decoder 2000 cannot be once again cited, as the Examiner does, for the decoder module as claimed, in accordance with the correct meaning of a “module”, since the same receiver/decoder 2000, by definition, cannot be used to simultaneously disclose two *separate and independent* self-contained units, such as the broadcast receiving module as claimed and the decoder module as claimed.

In the Advisory Action, the Examiner, however, fails to address any of the above-noted modularity arguments. Accordingly, at least due to the above-noted modularity distinction between the receiver/decoder 2000 of Leoporini and the claimed apparatus, Leoporini does not disclose, teach or suggest the claimed apparatus.

Indeed, as far as modularity is concerned, the receiver/decoder 2000 of Leoporini is no different from the conventional DMBR. Similar to the conventional DMBR, decoders of the receiver/decoder 2000 are also confined therewithin such that its decoders cannot do the

decoding independently of a CAS. See Fig. 4 (showing that data decoder 2024, audio decoder 2026 and video decoder 2028 only take as input output from descrambler/demux/remux 2010), and, for example, Fig. 14, and paragraph [0274] of Leoporini (showing that contents stored in hard disc 2100 for playback are subject to the control of a CAS (smartcard) for decryption before decrypted contents can only be sent to descrambler/demux/remux 2010, indicating that the decryption *always* occurred before any decoding is subject to the control of the CAS). Similarly, as far as modularity is concerned, as noted on page 13 of the May Amendment, the IRD 1140 of the cited secondary reference Martin is also no different from the conventional DMBR, since its decoding section (consisting of audio decoder 246 and video decoder 248) is likewise confined therewithin, and can only take as input (for decoding) output from the demultiplexer/descrambler 240 whose operation is subject to the control of CAS 238, thereby not being able to do the decoding independently of a CAS. See col. 7, lines 45-54 of Martin.

Accordingly, as far as modularity is concerned, both Leoporini's receiver and Martin's IRD are of the same nature as the conventional DMBR in that both of their decoders are respectively confined therewithin such that decoding cannot be done independently of a CAS. As such, Leoporini and Martin, taken singly or in combination, do not disclose, teach, or suggest the modularity feature as claimed. Accordingly, claim 1 should be allowable over Leoporini and Martin. The rejection of claim 1 should therefore be withdrawn.

II.

Further, as demonstrated in detail on pages 9-14 the May Amendment, neither the receiver/decoder 2000 of Leoporini nor the IRD1140 of Martin discloses, teaches, or suggests the decoder module as claimed. First, with respect to the decoding section (of the decoder module) as claimed, on pages 9-10 and 12 of the May Amendment, Applicants point out that neither Leoporini nor Martin discloses the decoding section as claimed, since the decoding section of their respective receiver or IRD is not disclosed as decoding data from two different independent sources and of different nature, such as decrypted data output from a broadcast receiving module and non-decrypted data received from a multimedia module, as is the case for the decoding section as claimed. However, in the Advisory Action, the Examiner fails to address this argument. Accordingly, the rejection of claim 1 should be withdrawn.

Second, with respect to the second demultiplexer as claimed, in the May Amendment, Applicants point out that, since the second demultiplexer as claimed works in concert with the first multiplexer as claimed (in allowing the decoding section to decode both decrypted data from the broadcast receiving module as claimed and non-decrypted data from a multimedia module), prior art references that do not disclose this “working-in-concert” relationship between two demultiplexers, such as Leoporini or Martin, simply do not disclose or suggest the second demultiplexer as claimed.

In the Advisory Action, while acknowledging that both Leoporini and Martin only disclose one demultiplexer, the Examiner contends that the second demultiplexer as claimed is obvious, alleging that *the lone demultiplexer disclosed in either Leoporini or Martin performs functions of the first demultiplexer as claimed and the second demultiplexer as claimed*, and citing *In re Karlson*, 311 F.2d 581, 584, 136 USPQ 184, 186 (CCPA 1963) as his legal basis. Applicants respectfully disagree with the Examiner’s assessment.

First, the Examiner’s allegation that the lone demultiplexer disclosed in either Leoporini (demux 2010) or Martin (demux 240) performs functions of the first demultiplexer as claimed and the second demultiplexer as claimed is clearly erroneous. As demonstrated above, in either Leoporini or Martin, the data which the lone demultiplexer receives for demultiplexing is always subject to the control of a CAS, regardless of whether contents of the data are initially obtained from a hard disk or a tuner. Therefore, the lone demultiplexer does not perform the functions of the second demultiplexer as claimed, namely *receiving non-decrypted digital multimedia data stream, which is independent of a CAS, and working in concert with the first multiplexer as claimed* in allowing the decoding section to also decode *non-decrypted data independent of a CAS*. Accordingly, the Examiner’s allegation, upon which his obviousness contention is premised, is incorrect.

Further, the Examiner’s citing of *In re Karlson* as his legal basis in support of his obviousness contention is totally misplaced. According to *In re Karlson*, the “omission” refers to “omission of element(s)” in *a claimed combination* in relation to a combination of prior art, not an “omission” in a combination of prior art, such as “omission” of a second demultiplexer in either Leoporini’s receiver or Martin’s IRD, as apparently referred to by the Examiner. See *In re Karlson* at 185 (holding that the removal of the screen and the tube *in the*

cited reference Shuldener, or the omission of the screen and the tube in the claimed combination, is obvious if the remaining elements perform the same function as before). In other words, in the instant case, there is no “omission” in the claimed combination, since the second demultiplexer as claimed is more of an “addition” than an “omission”, in relation to the conventional DMBR. As such, *In re Karlson*, in fact, is totally inapplicable to the instant case. Second, the underlying condition of the *In re Karlson* ruling is (as in fact noted by the Examiner) if the remaining elements perform the same function as (they were performed in the prior art) before. However, the decoding section as claimed, which is one of the remaining elements, performs *a different function from* the decoding section in either Leoporini or Martin, since the former may decode non-decrypted data *independent of a CAS* whereas the latter only decodes data decrypted by a CAS. Hence, for the instant case, the underlying condition of the *In re Karlson* ruling is not met. Therefore, even without regard to “whose omission” it is, *In re Karlson* is still inapplicable to the instant case.

Accordingly, the Examiner’s contention stated in the Advisory Action is incorrect. Therefore, the rejection of claim 1 should be withdrawn.


III.

Accordingly, for at least the same reasons stated above in connection with claim 1, the rejection of claim 9 as well as dependent claims 2-8 and 10-14 should also be withdrawn.

Conclusion

In view of the above, it is believed that there are at least one or more errors or omissions in the Examiner’s rejections.

Respectfully submitted,


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Dated: June 17, 2010